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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/532,937	03/22/2000	Stefan Georg Hild	RSW9-99-132	9182

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EXAMINER

ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/15/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/532,937

Applicant(s)

HILD ET AL.

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 30, 32 and 34 - 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 30, 32 and 34 - 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1 – 30, 32, 34 and 36 are presented for examination.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 11 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
3. The claims is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the description requirement thereof since the claims introduce new matter not supported by the original disclosure. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the design now claimed at the time the application was filed. See *In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).
4. Specifically, there is no support in the original disclosure of the teachings of a plurality of requested client properties being less than all available client properties found in the original

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discloser of the specification. Therefore, new subject matter will not be entered and the previous rejection still stands as restated below.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the a plurality of requested client properties being less than all available client properties must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

7. A person shall be entitled to a patent unless –

8. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 2, 11, 12, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Merriman et al. U.S. Patent No. 5948061 (hereinafter Merriman).

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10. Referencing claim 1, Merriman teaches in a networked environment, a method for designating client properties comprising:

11. receiving a link element associated with a server, that link element including a plurality of requested client properties, (e.g. col. 3, line 24 – col. 4, line 11 & col. 5, line 33 – col. 7, line 43);

12. selecting said link element to request a document identified by the link element to be transmitted to a client, (e.g. col. 3, line 24 – col. 4, line 11 & col. 5, line 33 – col. 7, line 43);

13. inserting at least one of said plurality of requested client properties into a request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties, (e.g. col. 3, line 24 – col. 4, line 11 & col. 5, line 33 – col. 7, line 43).

14. Referencing claim 2, Merriman teaches said plurality of requested client properties is contained within an attribute of said link element, (e.g. col. 3, line 24 – col. 4, line 11).

15. Claims 11, 12, 21 and 22 are rejected for similar reasons as stated above.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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17. (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 3, 13, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman et al. U.S. Patent No. 5948061.

19. Applicant has failed to seasonably challenge the Examiner's assertions of well known subject matter in the previous Office action(s) pursuant to the requirements set forth under MPEP §2144.03. A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in the next response. Accordingly, the claim limitations the Examiner considered as "well known" in the first Office action, i.e. PROFILEATTRS attribute, are now established as admitted prior art of record for the course of the prosecution. See In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

20. The rejection is restated for the Applicant to reference.

21. As per claim 3, Merriman does not specifically teach wherein said attribute is a PROFILEATTRS attribute.

22. Official Notice is taken that it was a common practice to have an attribute similar to PROFILEATTRS at the time the instant invention was made.

23. It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method/system disclosed by Merriman because if a link is selected from a web page and the link gathers information from the user, there is a program tag that give that link the ability to carry out that function. Furthermore, disclosed by the applicant on page 14, lines 9 – 13 states,

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24. “Though Figures 5A, 5B, and 5C show links annotated in a particular way, it is understood that alternative embodiments of this invention may employ a variety of different formats, including different attribute names (other than PROFILEATTRS), different syntax for listing requested properties, or different syntax for designated wild cards or mandatory attributes, it is understood that these alternative embodiments do not take away from the inventive constructs herein.”

25. Claims 13 and 23 are rejected for similar reasons as stated above.

26. Claims 4, 5, 14, 15, 24, 25, 32, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Gershman et al. (6401085) (hereinafter Gershman).

27. As per claim 4, Merriman does not specifically teach each one of said requested client properties comprises a category, a separator, and a property name. Gershman teaches each one of said requested client properties comprises a category, a separator, and a property name, (e.g. cols. 16 – 17). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman because if the program language requires the programmer to apply this type of context for the program to run properly, it would be in the best interest to use this syntax so that the invention would work.

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28. As per claim 5, Merriman does not specifically teach said plurality of requested client properties includes at least one property that is a wild card. Gershman teaches said plurality of requested client properties includes at least one property that is a wild card, (e.g. col. 21 – 22). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman because it would be more efficient for a user to utilize this very common utility as a wild card, (i.e. *.doc, hyper\$ism, ect.), to broaden a field of search.

29. As per claim 34, Merriman does not specifically teach at least one of the plurality of requested client properties is associated with hardware characteristics of the client. Gershman teaches at least one of the plurality of requested client properties is associated with hardware characteristics of the client, (e.g. col. 58, lines 21 – 29). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman because having hardware as at least one requested client property could aid in the transmission, storage and compatibility of the system that is transmitting the client information. For example, if a client wanted to download information after accessing a link and the user didn't have a fast enough transmission median, the server from which the download is coming from would know this from the transmitted hardware information that was requested from the client, therefore the server could make the necessary changes to make sure that the download transmits successfully without error or deny the client altogether.

30. Claims 14, 15, 24, 25, 34 and 36 are rejected for similar reasons as stated above.

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31. Claims 6, 7, 10, 16, 17, 20, 26, 27, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Heidorn et al. (6098081) (hereinafter Heidorn).

32. As per claim 6, Merriman does not specifically teach said plurality of requested client properties includes at least one property that is designated as a mandatory property. Heidorn teaches said plurality of requested client properties includes at least one property that is designated as a mandatory property, (e.g. col. 7, lines 18 – 27). It would have been obvious to one skilled in the art at the time the invention was made to combine Heidorn with Merriman because it would be more efficient for a system to have at least one property that the system could use to identify a user. If there is no property for a user then the user does not exist in the system.

33. As per claim 7, Merriman does not specifically teach said step of inserting comprises the steps of:

34. selecting each one property from said plurality of requested client properties; and

35. determining whether said each one property is available to be transmitted. Heidorn teaches said step of:

36. inserting comprises the steps of selecting each one property from said plurality of requested client properties, (e.g. col. 3, line 56 – col. 4, line 34); and

37. determining whether said each one property is available to be transmitted, (e.g. col. 3, line 56 – col. 4, line 34). It would have been obvious to one skilled in the art at the time the

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invention was made to combine Heidorn with Merriman because it would be more efficient if the system error check to see if the system or user had specific property data to transmit to the system. If the system didn't have this function it could cause error in the system and build a property list or table that has incorrect property information about a user making the system flawed.

38. As per claim 10, Merriman does not specifically teach the step of terminating the request if a mandatory property is not available to be transmitted. Heidorn teaches the step of terminating the request if a mandatory property is not available to be transmitted, (e.g. col. 3, line 56 – col. 4, line 34). It would have been obvious to one skilled in the art at the time the invention was made to combine Heidorn with Merriman because if the user didn't have the information that is mandatory for the system to function then the system would not be able to execute its functions therefore, making the inventions function useless.

39. Claims 16, 17, 20, 26, 27, 30 are rejected for similar reasons as stated above.

40. Claims 8, 9, 18, 19, 28, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Heidorn (6098081) in further view of Gershman (6401085).

41. As per claim 8, Merriman and Heidorn do not specifically teach said step of selecting further comprises expanding a wildcard property. Gershman teaches said step of selecting further comprises expanding a wildcard property, (e.g. cols. 21 – 22). It would have been obvious to one

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skilled in the art at the time the invention was made to combine Gershman with Merriman and Heidorn because it would be more efficient for the system to be able to utilize the function of a wild card, (i.e. the ability of have a symbol to stand for different files and/or letters).

42. As per claim 9, Merriman does not specifically teach said step of determining further comprises prompting a user whether to transmit said each one property. Heidorn teaches said step of determining further comprises prompting to transmit said each one property, (e.g. col. 3, line 56 – col. 4, line 34 & col. 7, lines 18 – 27), but does not teach said step of determining further comprises prompting a user whether to transmit. Gershman teaches said step of determining further comprises prompting a user whether to transmit, (e.g. col. 3, lines 14 – 29 & col. 43, line 45 – col. 44, line 14). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman and Heidorn with Merriman because make a system have more versatility for a user that would want to utilize the system but would not want to divulge certain information that would be considered private and/or vital to a user, (i.e. cookies that might have credit card information, social security number). Having this option would make a user more likely to utilize the invention for it security reasons.

43. Claims 18, 19, 28, 29 are rejected for similar reasons as stated above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333.


The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is none.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is none.

David E. England
Examiner
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De 


DAVID WILEY
SUPERVISORY PATENT EXAMINER
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